



Express Mail No. EL963889392US
US Application No. 09/939,911
Docket No. G08.003

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: WILCE et al.

Serial No.: 09/939,911

Filing Date: August 27, 2001

For: SYSTEMS AND METHODS FOR
FACILITATING USE OF AGREEMENT
INFORMATION VIA AN AGREEMENT
MODELING SYSTEM

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) Examiner: SHAH, ANKEETA

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) Group Art Unit: 3628

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) Attorney Docket No.: G08.003

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)
) **PETITION TO MAKE SPECIAL
PURSUANT TO MPEP 708.02 (VIII)**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a Petition to Make Special for accelerated examination of the above-referenced utility application filed on August 27, 2001. This Petition is being filed along with a letter requesting a pre-first Office action interview pursuant to the U.S. Patent Office Pilot Program set forth in OG Notices: 27 April 2004.

This Petition to Make Special is being made under MPEP 708.02 (VIII). In accordance with that section, Applicants hereby request and submit:

A. The present Petition to Make Special and fee of \$130 as set forth in 37 CFR 1.17(i). The Commissioner is authorized to charge any further fees or to credit any over payments to Deposit Account No. 50-1852.

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B. Upon entry of the Preliminary Amendment filed herewith, the application will include a set of claims (claims 17-23 and 41-55) directed to a single invention.

C. Applicants have caused a pre-examination patentability search to be made. In particular, Applicants commissioned a patentability search on August 3, 2004, and the resulting search report indicates that a search was made in the following classes:

<u>Class</u>	<u>Subclass</u>
395	701
705	035, 4, 29, 36, 37, 38, 39
707	200, 530, 531
709	238, 22

The search report also indicates that US Full Text and US Published Patent Applications were searched via the US PTO. US Full Text, US Published Patent Applications, and PCT Applications were also searched via LEXIS-NEXIS and DELPHION according to the search report.

In addition to the patent literature described above, the search report indicates that the following sources were searched: LEXIS-NEXIS (*e.g.*, General News, Industry News, and Wall Street & Technology), DIALOG, E-RESOURCES, governmental information (*e.g.*, associated with the US Securities and Exchange Commission), journals, and general Internet searches (*e.g.*, GOOGLE).

The search report further indicates that combinations of the following search terms were used during these searches: agreements, limits, electronic, audit, binding, transaction, generate, artificial intelligence, contracts, responsibilities, online, accounting, period, query, document, terms, modeling system, management, legal, user, facilitate, agent.

Moreover, according to the search report the following search strings were used:

- o ((modeling system) <near/5> (agreement or legal or negotiation or contract))
- o (((generate <near/5> (agreement and legal and contract))))
- o (((generate <near/5> (agreement and legal and contract)))) and (financial <near/5> (instrument or service or option or trade or transaction))
- o (electronic contract) w/5 (facilitate or online or generate)

- o (electronic pre/1 agreement) and (contract)

D. An Information Disclosure Statement (IDS) filed concurrently herewith contains a copy of each relevant reference identified as a result of the pre-examination search. Applicants note that this is the fifth IDS filed in this case. This Petition will address the references from all five disclosures that Applicants consider most closely related to the subject matter of the claims.

E. The independent claims of the application are:

17. A method for utilizing an agreement modeling system, comprising:

receiving an indication of an agreement between a party and a counter-party, the agreement including an agreement term associated with a term date;

receiving an indication of a transaction associated with a transaction date;

receiving an indication of a query date, the query date being a date other than the date on which the indication of the query date was received; and

determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date, and the query date.

52. An apparatus for utilizing an agreement modeling system, comprising:

a processor; and

a storage device in communication with said processor and storing instructions adapted to be executed by said processor to:

receive an indication of an agreement between a party and a counter-party, the agreement including an agreement term associated with a term date;

receive an indication of a transaction associated with a transaction date;

receive an indication of a query date, the query date being a date other than the date on which the indication of the query date was received; and

determine an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date, and the query date.

55. A medium storing instructions adapted to be executed by a processor to perform a method of utilizing an agreement modeling system, said method comprising:

receiving an indication of an agreement between a party and a counter-party, the agreement including an agreement term associated with a term date;

receiving an indication of a transaction associated with a transaction date;

receiving an indication of a query date, the query date being a date other than the date on which the indication of the query date was received; and

determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date, and the query date.

F. Applicants submit a detailed discussion of the references (from all four Information Disclosure Statements) that Applicants consider most closely related to the subject matter of the claims as follows:

US Patent No. 5,692,206 ("Shirley")

Some embodiments of the present invention are directed to an agreement modeling system in which an agreement term is associated with one or more term dates. For example, as illustrated in FIG. 13 of the present application, an amendment to an original agreement might be apply from an effective date to an expiration date. Moreover, an agreement term might be defined or entered on still another date. For example, an amendment entered on July 10th, 2005 might be effective from January 1, 2004 through December 31, 2004 (*e.g.*, the amendment applies to a period in the past).

Claim 17 recites "receiving an indication of a transaction associated with a transaction date." For example, information about an exchange of an interest rate product that took place on January 5, 2004 might be received.

Claim 17 further recites "receiving an indication of a query date, the query date being a date other than the date on which the indication of the query date was received." For example, on July 15th 2005, a party to the agreement might be interested in whether or not the exchange of the interest rate product described above would have been allowed under the contract as of June 1, 2005.

Claim 17 also recites "determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date, and the query date." In the current example, as of June 1, 2005 the exchange may not have been allowed (*e.g.*, because the retroactive amendment was not entered until after that date). Applicants note that independent claims 52 and 55 contain almost identical limitations.

Shirley discloses a system to author a contract, including alternate, supplemental, and additional provisions in the contract (*e.g.*, col. 16, lines 25-31). Although Shirley describes a way of creating a contract, it does not disclose "determining an applicability of [an] agreement term as of [a] query date based at least in part on [a] term date, [a] transaction date, and the query date." In fact, Shirley does not disclose or suggest any use of the system to evaluate transactions after the document is created (*e.g.*, col. 20, lines 25-32).

US Patent No. 6,067,531 ("Hoyt")

Hoyt discloses a system to automate the negotiation and generation of contract documents. As with Shirley, it does not disclose or suggest any use of the system to evaluate transactions after the contract document is created (*e.g.*, col. 8, lines 10-31). Therefore, nothing in Hoyt teaches or suggests "determining an applicability of [an] agreement term as of [a] query date based at least in part on [a] term date, [a] transaction date, and the query date."

US Patent No. 6,236,984 ("Owens")

Owens discloses a system to generate and update contracts. Owens does not disclose or suggest any use of the system to evaluate transactions after the contract document is created (*e.g.*, col. 9, lines 3-15). Therefore, nothing in Owens teaches or suggests "determining an

applicability of [an] agreement term as of [a] query date based at least in part on [a] term date, [a] transaction date, and the query date."

US Publication No. 2002/0038278 ("Himmelstein")

Himmelstein discloses a system for exchanging or bartering items, including securities. Moreover, agreements controlling with such exchanges may be associated with a range of dates (*e.g.*, paragraph [0035]). Himmelstein, however, does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received." That is, Himmelstein does not disclose that user might want to determine whether or not a particular agreement term was applicable to a transaction as of some other date.

US Publication No. 2002/0042782 ("Albazz")

Albazz discloses a system to generate a contract. Moreover, the system can be used to govern activities under the contract. (*e.g.*, paragraph [0099]). Albazz, however, does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received." That is, Albazz does not disclose that user (*e.g.*, a party to the agreement or another device) might want to determine whether or not a particular agreement term was applicable to a transaction as of some past (or future) date.

US Patent No. 6,421,653 ("May")

May discloses a system to electronically trade financial instruments. The system can be used to process transactions (*e.g.*, col. 51, lines 50-61). May does not disclose or suggest, however, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in May might evaluate a transaction currently being executed, but it does not let a party determine whether or not a particular agreement term was applicable to a transaction as of a different date.

US Publication No. 2002/0023034 ("Brown")

Brown discloses a system that can be used to exchange assets which are defined as digital automated equities. Although the system may be used to execute transactions (*e.g.*, paragraph [0081]), Brown does not disclose or suggest, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Brown might evaluate a transaction that is currently being negotiated, but it does not let a party determine whether or not a particular agreement term was applicable to a transaction as of a different date.

US Publication No. 2002/0198817 ("Dhir")

Dhir discloses an online platform to trade assets, access capital, and to manage information. The platform can be used to evaluate a transaction based on terms and conditions associated with a party (*e.g.*, paragraphs [0156] through [0160]). Dhir, however, does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received."

US Patent No. 5,970,479 ("Shepherd")

Shepherd discloses a system that can help manage risks related to specified future events. The system may be used to automatically compare order parameters (*e.g.*, col. 17, lines 43-50) and orders may be associated with time limits (*e.g.*, col. 17, line 16 - col. 18, line 3). The orders evaluated in Shepherd, however, are orders currently being processed (*e.g.*, col. 20, lines 45-48 and col. 22, line 1 through col. 24, line 52). Thus, Shepherd does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received" as recited in the pending claims.

US Patent No. 6,125,391 ("Meltzer")

Meltzer discloses self-defining electronic documents that can be used to conduct transactions via a communication network. In particular, the documents can be used by a party

to identify itself and the other types of documents with which it would like to transact business (*e.g.*, col. 23, lines 45-50 and col. 30, lines 53-56). Meltzer does not disclose or suggest, however, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Meltzer might evaluate a transaction currently being executed, but it does not let a party determine whether or not a particular agreement term was applicable to a transaction as of a different date.

US Patent No. 6,778,968 ("Gulati")

Gulati discloses an automated network-based exchange system to control the exchange of objects, such as secondary market auctions. Although Gulati discloses that the automated exchange can include an electronic contract negotiation service (*e.g.*, col. 27, lines 42-66) and a delivery/auditing service sub-exchange (*e.g.*, col. 39, line 66 to col. 40, line 12), it does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Gulati evaluates potential exchanges, but it does not let a party determine whether or not a particular agreement term was applicable to a transaction as of some other date.

US Publication No. 2087534A1 ("Blackman")

Blackman disclosed an agreement management system for organizing information around agreements. The system includes an agreement database to store agreements and information directly related to those agreements. Changes can be made to the agreements (*e.g.*, paragraph [0231]) and compliance with the agreement can be monitored (*e.g.*, paragraph [0234]). Nowhere, however, does Blackman suggest that a "query date being a date other than the date on which the indication of the query date was received" as recited in the pending claims. In particular, there is no way for a party using the system disclosed in Black to determine if an agreement term was applicable from the perspective of another date.

US Publication No. 2010686A1 ("Whitesage")

Whitesage discloses a system to manage purchasing contracts between suppliers and customers. The purchases contracts may be automatically generated after contract terms are defined (*e.g.*, paragraph [0067]). In some cases, transaction terms associated with the purchasing contract may include a beginning and ending date (*e.g.*, paragraph [0110]). Such dates may be, for example, entered by an operator (*e.g.*, paragraph [0136]). Whitesage does not disclose, however, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Whitesage might let an operator define a beginning and ending date associated with a purchasing contract, but the operator cannot determine if a particular agreement term was applicable to a transaction as of some other date.

US Publication No. 2095311A1 ("Donahue")

A system to facilitate a structured negotiation between a landlord and a potential tenant is disclosed in Donahue (*e.g.*, paragraph [0066]). Some of the terms of a lease may be associated with dates (*e.g.*, paragraph [0128]). Although the parties may negotiate when the lease will begin and end, Donahue does not disclose a "query date being a date other than the date on which the indication of the query date was received." In fact, Donahue does not disclose that the system is to be used to evaluate transactions after the lease is created at all.

US Publication No. 2111922A1 ("Young")

Young discloses a contract management system. In particular, a user or another application can supply contract information, or the contract information may received from another application (*e.g.*, paragraph [0129]). Differences between parties over the particular contract terms can be resolved and sales under a contract can be monitored (*e.g.*, paragraphs [0136] and [0144]). Young does not remotely disclose or suggest, however, a "query date being a date other than the date on which the indication of the query date was received."

US Publication No. 4010463A1 ("Hahn-Carlson")

Hahn-Carlson discloses a system in which contract terms are automatically set for a transaction based on business rules previously established between parties to a transaction. For example, pricing rules may be used to define pricing data for a contract (*e.g.*, paragraph [0050]). Hahn-Carlson does not disclose, however, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Hahn-Carlson might automatically determine a price associated with a transaction, but an operator (*e.g.*, a person or an application) cannot determine if a particular agreement term applied to a transaction as of another date.

International Publication No. WO0175745A1 ("Whitesage")

Whitesage discloses a system to manage purchasing contracts between suppliers and customers. The purchasing contracts may be automatically generated after contract terms are defined (*e.g.*, page 14, second whole paragraph). In some cases, transaction terms associated with the purchasing contract may include a beginning and ending date (*e.g.*, page 19). Such dates may be, for example, entered by an operator (*e.g.*, last paragraph beginning on page 25). Whitesage does not disclose, however, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Whitesage might let an operator define a beginning and ending date associated with a purchasing contract, but the operator cannot determine if a particular agreement term was applicable to a transaction as of some other date.

International Publication No. WO0210935A1 ("Hazard")

Hazard discloses a network-based agreement formation system that uses stored contract terms and supplements to contract terms. Hazard further discloses that electronic messages may be used to let parties select appropriate terms (*e.g.*, page 9, line 30 to page 10, line 5). Hazard does not disclose, however, "determining an applicability of [an] agreement term as of [a] query date based at least in part on [a] term date, [a] transaction date, and the query date." In fact,

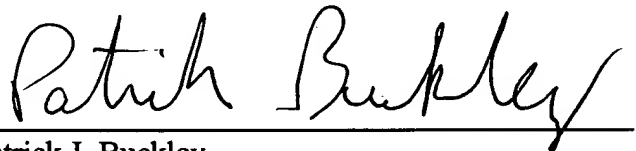
Hazard does not disclose or suggest any use of the system to evaluate transactions after the document is created.

International Publication No. WO9621903A1 ("King")

King discloses an automated system of accepting risk through contractual obligations. In particular, agreements can be created which promise payments based on loss from investment risks. The terms of contractual obligations may also be evaluated to see if the obligation is appropriate. For example, the risk of a particular enterprise might be limited to a pre-determined amount (e.g., page 31, lines 26 to 35). Once the obligation is created, however, King does not disclose "determining an applicability of [an] agreement term as of [a] query date based at least in part on [a] term date, [a] transaction date, and the query date." Nor does King disclose a "query date being a date other than the date on which the indication of the query date was received."

On the basis of the foregoing, Applicants respectfully request the granting of this Petition so that the application will be taken up promptly and respectfully solicit favorable examination at that time.

Respectfully submitted,



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(203) 972-0191

October 20, 2004

Date

cc: John J. Love
Technology Center Director 3600
via facsimile to (703) 306-4597
(w/o Preliminary Amendment, IDS, and copies of references)



Express Mail No. EL963889392US
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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FACILITATING USE OF AGREEMENT
INFORMATION VIA AN AGREEMENT
MODELING SYSTEM

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) Examiner: SHAH, ANKEETA

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) Group Art Unit: 3628

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) Attorney Docket No.: G08.003

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) **LETTER REQUESTING PRE-FIRST**
) **OFFICE ACTION INTERVIEW**
) **PURSUANT TO PILOT PROGRAM SET**
) **FORTH IN OG NOTICES: 27 APRIL 2004**
)

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a letter requesting a pre-first Office action interview pursuant to the U.S. Patent Office Pilot Program set forth in OG Notices: 27 April 2004. This letter is being filed along with a Petition to Make Special pursuant to MPEP 708.02 (VIII), a 4th Supplement Information Disclosure Statement (and copies of the cited references), and a Preliminary Amendment. According to information obtained from the Patent Application Information Retrieval (PAIR) system, the present application is classified in Class 705/Subclass 035 and is assigned to Art Unit 3628. In accordance with the requirements of the Pilot Program, Applicants hereby submit:

(a) A General Statement of the State of the Art at the Time of the Invention:

An agreement between a party and a counter-party may be manually defined and generated by the parties. For example, one or both of the parties might manually select a type of document that appropriately reflects the substance of the agreement (*e.g.*, a particular type of

contract) and/or agreement terms to be included in the document (*e.g.*, contract clauses). Such manual approaches, however, can be time consuming and error-prone.

It is also known that some elements of an agreement process can be automated. Even such automated approaches, however, do not address the potentially dynamic relationships that may exist between a party and a counter-party. For example, an agreement may be frequently amended to reflect new financial products or credit limits, and these amendments may be inter-related or retroactive. Such amendments are typically created as separate documents, making it difficult to ascertain the current status of an agreement, let alone the status of the agreement on a particular date in the past.

(b) An Identification of Three References Believed to be "Closest" Prior Art and an Explanation as to How the Broadest Claim (Claim 17) Distinguishes Over the Submitted Prior Art:

US Publication No. 2002/0038278 ("Himmelstein")

Some embodiments of the present invention are directed to an agreement modeling system in which an agreement term is associated with one or more term dates. For example, as illustrated in FIG. 13 of the present application, an amendment to an original agreement might be apply from an effective date to an expiration date. Moreover, an agreement term might be defined or entered on still another date. For example, an amendment entered on July 10th, 2005 might be effective from January 1, 2004 through December 31, 2004 (*e.g.*, the amendment applies to a period in the past).

Claim 17 recites "receiving an indication of a transaction associated with a transaction date." For example, information about an exchange of an interest rate product that took place on January 5, 2004 might be received.

Claim 17 further recites "receiving an indication of a query date, the query date being a date other than the date on which the indication of the query date was received." For example, on July 15th 2005, a party to the agreement might be interested in whether or not the exchange of

the interest rate product described above would have been allowed under the contract as of June 1, 2005.

Claim 17 also recites "determining an applicability of the agreement term as of the query date based at least in part on the term date, the transaction date, and the query date." In the current example, as of June 1, 2005 the exchange may not have been allowed (*e.g.*, because the retroactive amendment was not entered until after that date). Applicants note that independent claims 52 and 55 contain almost identical limitations.

Himmelstein discloses a system for exchanging or bartering items, including securities. Moreover, agreements controlling with such exchanges may be associated with a range of dates (*e.g.*, paragraph [0035]). Himmelstein, however, does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received." That is, Himmelstein does not disclose that user might want to determine whether or not a particular agreement term was applicable to a particular transaction as of some date other than the current date.

US Patent No. 5,970,479 ("Shepherd")

Shepherd discloses a system that can help manage risks related to specified future events. The system may be used to automatically compare order parameters (*e.g.*, col. 17, lines 43-50) and orders may be associated with time limits (*e.g.*, col. 17, line 16 - col. 18, line 3). The orders evaluated in Shepherd, however, are orders currently being processed (*e.g.*, col. 20, lines 45-48 and col. 22, line 1 through col. 24, line 52). Thus, Shepherd does not disclose or suggest a "query date being a date other than the date on which the indication of the query date was received" as recited in the pending claims.

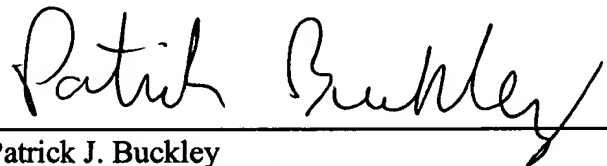
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Whitesage discloses a system to manage purchasing contracts between suppliers and customers. The purchases contracts may be automatically generated after contract terms are defined (*e.g.*, paragraph [0067]). In some cases, transaction terms associated with the purchasing contract may include a beginning and ending date (*e.g.*, paragraph [0110]). Such

dates may be, for example, entered by an operator (*e.g.*, paragraph [0136]). Whitesage, does not disclose, however, a "query date being a date other than the date on which the indication of the query date was received." That is, the system disclosed in Whitesage might let an operator define a beginning and ending date associated with a purchasing contract, but the operator cannot determine if a particular agreement term was applicable to a transaction as of a some other date.

Applicants hereby respectfully request a pre-first Office action interview and allowance of the pending claims. If any issues remain with this letter or the associated Petition, the Patent Office is kindly invited to contact the undersigned via telephone at (203) 972-0191.

Respectfully submitted,



Patrick J. Buckley

Registration No. 40,928

Buckley, Maschoff & Talwalkar LLC

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(203) 972-0191

October 20, 2004

Date

cc: John J. Love
Technology Center Director 3600
via facsimile to (703) 306-4597
(w/o Preliminary Amendment, IDS, and copies of references)